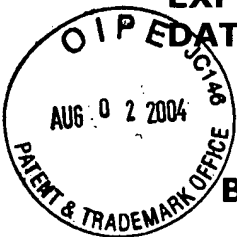


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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicants:	Donald E. Weder	) Art Unit: 1775
		)
Serial No.:	09/764,365	) Examiner: S. Stein
		)
Filed:	Jan 18, 2001	) Atty Dkt. No.: 8403.186
		)
Reissue of:	U.S. Patent No. 5,861,199	)
		)
Issued:	January 19, 1999	)

For: **OPTICAL EFFECT MATERIAL AND METHODS**

**APPELLANT'S REQUEST TO REINSTATE APPEAL AND SUPPLEMENTAL  
APPEAL BRIEF**

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**I. REAL PARTY IN INTEREST**

As set forth in the Appeal Brief, Examiner's Answer and Reply Brief.

**II. RELATED APPEALS AND INTERFERENCES**

As set forth in the Appeal Brief, Examiner's Answer and Reply Brief.

**III. STATUS OF CLAIMS**

As set forth in the Appeal Brief, Examiner's Answer and Reply Brief.

**IV. STATUS OF AMENDMENTS AFTER FINAL**

As set forth in the Appeal Brief, Examiner's Answer and Reply Brief.

**V. SUMMARY OF INVENTION**

As set forth in the Appeal Brief, Examiner's Answer and Reply Brief.

**VI. ISSUE ON REINSTATEMENT OF APPEAL**

Whether an incorrect priority claim in an issued patent may be corrected during a reissue application pursuant to 35 U.S.C. § 251 and 37 C.F.R. § 1.171

**VII. GROUPING OF CLAIMS**

As set forth in the Appeal Brief, Examiner's Answer and Reply Brief.

**VIII. CLAIMS APPEALED**

As set forth in the Appeal Brief, Examiner's Answer and Reply Brief.

**IX. PRIOR ART OF RECORD**

As set forth in the Appeal Brief, Examiner's Answer and Reply Brief.

**X. NEW GROUNDS OF REJECTION**

As set forth in the Decision Terminating Proceedings mailed June 2, 2004.

## **XI. APPELLANT'S CONTENTIONS WITH REGARD TO NEW GROUNDS OF REJECTION.**

### **Statement of Facts**

On September 20, 1996 the applicant filed Application 08/717,469. Application '469 inadvertently referred back in the continuing data to Application No. 06\613,080 filed May 22, 1984. Application '469 issued into Patent No. 5,861,199 on January 19, 1999. On January 18, 2001 the Applicant filed his reissue application No. 09/764,365. The error upon which this reissue was based was that the patent was partly inoperative or invalid because it incorporated or referenced back further than was required for patentability.

The inclusion of this "continuing data" was a holdover from the Applicant's previously harmless pre-GATT practice of including all family members solely for the purpose of informing the public of other related applications and patents. The purely discretionary non-substantive former practice now threatens to make this patent wholly or partly inoperative or invalid. Since this continuing data could have been eliminated at any time during the pendency of the application, it follows that the failure to do so, without deceptive intent, is an error that should be corrected through reissue proceedings. Thus, the applicant seeks to amend the "Related U.S. Application Data" so as to read as follows:

This application is a reissue of U.S. Application No. 08/717,469 filed September 20, 1996, now U.S. Patent No. 5,861,199, which is a continuation in part of U.S. Application No. 08/454,474, filed May

30 1995, now U.S. Patent No. 5,701,720, which is a continuation of U.S. Application No. 08/179,057, filed January 7, 1994, now U.S. Patent No. 5,576,089.

If the applicant is not allowed to amend the continuing data the patent will have expired on May 22, 2004.

On May 28, 2004 the Examiner mailed a non-final office action rejecting all the claims in the reissue application on the basis that the USPTO is authorized to grant a reissue patent only to correct a patent deemed wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent. In support thereof the examiner relied upon inter alia, 35 U.S.C. § 251 and In re Morgan 990 Fed 1230, 26USPQ2d 1392 (Fed. Cir. 1993).

Previously, on May 29, 2002 in reissue Application No. 09/678,217 (which referenced this reissue application and included the same issues as this reissue application) the Applicant had filed a Notice of Appeal to the Board of Patent Appeals and Interferences. Oral hearing was set on February 5, 2004. After oral argument the Board of Patent Appeals and Interferences remanded reissue application '217 back to the Examiner for further consideration and directed the Examiner to either furnish a supplemental Examiner's answer to the argument set forth in the Applicant's reply brief or take other appropriate action (e.g., withdraw the rejection).

In an office action mailed on March 10, 2004 in the '217 reissue

application, the Examiner determined the other appropriate action to be taken was to reopen prosecution and enter a "new" rejection of claims 1-38 under 35 USC 251. (Office action mailed 3/10/2004 page 2 paragraph 1) More specifically, the Examiner stated:

Upon further consideration, it is determined that the other appropriate action to be taken in the above-identified reissue application is to reopen prosecution under 37 CFR 1.193(b)(1) to enter a new rejection of claims 1 through 38 under U.S.C. § 251.

Claims 1 through 38 are rejected under 35 U.S.C. §251 on the basis that the changes being sought by reissue would not correct a patent "deemed wholly or partly inoperative or invalid within the meaning of 35 U.S.C. §251. The Director is authorized to reissue a patent only when a "patent is, through error without deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent" See 35 U.S.C. §251, ¶1...

The Examiner further stated that because prosecution had been reopened the Applicant must exercise one of the following two options to avoid abandonment. 1) file a reply under 37 CFR 1.111 or 2) request reinstatement of the Appeal. Appellant has elected to request reinstatement of the appeal in the '217 reissue application. And, in anticipation of a similar rejection in this reissue application, the Appellant also requests reinstatement of the appeal in this case.

On June 2, 2004 the USPTO *Sua Sponte* mailed a "DECISION TERMINATING PROCEEDINGS". The "DECISION TERMINATING PROCEEDINGS"

stated that said proceedings were terminated in view of the expiration of U.S. Pat. No. 5,861,199. In arriving at this conclusion, the USPTO relied upon 35 U.S.C. § 251 and In re Morgan, 990 Fed 1230, 26 USPQ 1392 (Fed. Cir. 1993).

The Decision Terminating Proceedings also set forth:

This is not a final agency action within the meaning of 5 U.S.C. § 704. Any request for further review of this matter must be made by way of petition under 37 CFR 1.181(a)(3).

• • • •

Since proceedings in the above-identified reissue application are hereby terminated, the above identified application will be forwarded to Technology Center 3700 for processing as an abandoned application.

On July 14, 2004 the Examiner mailed a "Notice of Abandonment" to Applicant's counsel. Applicant has petitioned the Commissioner to hold the Decision Terminating Proceedings and the Notice of Abandonment in Abeyance and Applicant hereby elects to request reinstatement of the Appeal.

### **LEGAL ARGUMENT**

The Examiner primarily relies on In re Morgan, 990F.2d 1230, 1231, 26USPQ2d 1392, 1393 (Fed. Cir. 1993) in support of the Examiner's proposition that the Commissioner has authority to reissue a patent only "for the unexpired term of the original patent" and therefore, Applicant's requested correction impermissibly lengthens the term. In re Morgan is, however, clearly distinguishable from the present reissue application and the Examiner's reliance

thereon is misplaced.

In re Morgan involved a situation wherein Morgan attempted to reissue U.S. Patent No. 3,900,645 four different times over a period of approximately 15 years. Morgan filed his first reissue application in 1977 under the then existing “no defect” rule. The Board of Appeals affirmed the rejection of Morgan’s unamended claims on substantive grounds and the Court of Customs and Appeals affirmed. Morgan then filed a continuation reissue application and later abandoned it. Three years later Morgan filed a third reissue application with an amended claim 1. The Board then reafter affirmed a rejection over the same references relied upon in the first reissue. Morgan did not appeal and in 1989 Morgan filed a fourth reissue application with claim 1 amended in a different manner from that in the previous application and adding a new independent claim 5. The Board affirmed a 35 U.S.C § 112 rejection, a 35 U.S.C. § 103 rejection based upon the same references relied upon in the previous applications and under 35 U.S.C. § 251 for new matter. The patent expired on August 19, 1992 while the appeal was pending and on October 7, 1992 the Commissioner moved to dismiss the appeal arguing that there is no “unexpired” term for which it had authority to reissue the patent and the case is moot. The Court granted the motion.

Unlike the present reissue application, at no time in In Re Morgan was the erroneous inclusion of continuing data or the “unexpired” term of the patent at



issue. Rather, Morgan simply ran out of his unexpired term in which to correct the alleged error. Morgan's rightful unexpired term was never in question as is in the present application.

The very issue the applicant has sought to resolve via the present reissue application, is to acquire the correct "unexpired" term of the '199 Patent to which Applicant was and is entitled. In fact, the Board in its first review of this issue seemed to imply that amendment of the continuing data is an error that can be remedied via a reissue application, in that, the Board did remand the reissue application to the examiner to either furnish a supplemental examiner's answer or take other appropriate action (e.g., withdraw the rejection). If the applicant's analysis is accurate and the defect sought to be corrected is indeed correctable through reissuance, the "unexpired" term of the '199 Patent is until Jan 7, 2014.

If the "Decision Terminating Proceedings" is allowed to stand, the very error Applicant sought to correct will be used to preempt the Board's authority to decide the legal issue for which the reissue application was sought. The Applicant respectfully submits that he should be permitted his day before the Board and allowed full judicial resolution of this issue. Indeed, as there is no case law on point with respect to the issue on appeal, a substantive resolution of the issue on the merits would best serve all interested parties – e.g. the Applicant, the USPTO and the public at large.

35 U.S.C. §251 provides for the reissue of an application where “a patent is, through error without any deceptive intention, deemed inoperative or invalid, by reason of a defective specification or drawing, or by the patentee claiming more or less than he had a right to claim in the patent.” (Emphasis added) Thus, the purpose of the reissue statute is to correct any defect in the original patent which crept into the patent without any deceptive intent on the part of the patentee that impairs the patentee’s rights. In order to obtain the reissuance of a patent, a patentee must meet five basic requirements: (1) the patent must be deemed wholly or partly inoperative or invalid due to a defect; (2) the defect arose through error and without any deceptive intent; (3) the reissue sought does not introduce “new matter”; (4) enlarging reissues must be filed within 2 years from issuance; and (5) the subject matter claimed in the reissue application meets the requirements of patentability. *Chisum on Patents*, 4:15.03, page 15-31. In the instant case, all the requirements of patentability are met.

The Applicant is merely attempting to correct an erroneous claim of priority and, consequently, recapture the full and rightful original term of the issued patent to which he is statutorily entitled. The Applicant’s use of the reissue statute to correct such an error is appropriate and well within the scope of this broad remedial statute.

The resolution of this issue turns on a legal question of statutory

construction. A remedial statute must be interpreted broadly in order to effectuate its purpose. The reissue statute's main purpose is to allow Applicants to correct mistakes that unnecessarily limit the scope of patent protection to which they are legally entitled. Unnecessary priority information that was not required for patentability was mistakenly included in U.S. Patent No. 5,861,199 as originally issued, without deceptive intent on the part of the Applicant. Pursuant to 35 U.S.C. § 251, such a mistake or error resulted in (1) an error which rendered the patent wholly or partly inoperative, and (2) causes a severe, unjustifiable, and inequitable loss of patent protection - i.e. a substantially and unnecessarily shortened term. The correction of the error in the '199 patent would merely reinstate the full original unexpired term to which the Applicant is entitled. Such an outcome is surely equitable and well within the goals and purposes of the reissue statute.

The Congressional purpose behind 35 U.S.C. §251 is to prevent correctable errors from "forever depriv[ing] a patent applicant of a priority right to which he would otherwise be entitled." *Brenner v. State of Israel*, 400 F.2d 789, 791 (1968). Though *Brenner* is not specific to the unique situation that has arisen in the present case, *Brenner* is directly on point and instructive with respect to a scenario in which the Applicant received less than he was entitled due to an incorrect claim of priority.

The Applicant's inadvertent and mistaken reference to earlier applications

significantly and unnecessarily reduces the patent term (i.e. the original patent term) to which the Applicant is otherwise entitled. If the cross-reference section in the '199 patent were properly corrected through this reissue application, the Applicant would be granted the patent that is guaranteed by 35 U.S.C. § 154. The legislative history makes it clear that equity shall guide 35 U.S.C. § 251 actions. See e.g. *Sampson v. Commissioner of Patents*, 195 U.S.P.Q. 136, 136 (D.D.C. 1976). An easily correctable error is keeping the Applicant from fully enjoying the full original patent term to which he is entitled.

Pursuant to 35 U.S.C. § 154, the '199 patent is entitled to a term of 20 years from the priority date that is necessary for patentability. The “term of the original patent” is defined by 35 U.S.C. 154, as being that period of time to which the Applicant was and is entitled to protection. Without the error of which the Applicant complains, the original term of the patent would be 20 years from January 7, 1994 – – i.e. January 7, 2014.

Direct and conclusive evidence that the Applicant unintentionally and inadvertently included erroneous continuing data, (i.e. continuing data that was not necessary for patentability), is of record and is uncontested. At no time was the Applicant attempting to gain a priority advantage to the May 22, 1984 date. The Information Disclosure Statement filed by the Applicant shows approximately 31 patents having issue dates after the May 22, 1984, the “filing date” or “priority date” alleged by the Applicant as being erroneous.

Furthermore, the 31 patents with issue dates after May 22, 1984 were apparently considered by the Examiner. The Examiner initialed that he considered each and every such referenced cited on the PTO form 1449 and as such, these referenced are explicitly listed under the "References Cited" section of the issued patent.

Thus, the original term of the '199 must necessarily be calculated from the correct and earliest priority date that is alleged to be required for patentability - January 7, 1994. The Applicant is seeking to correct this error and thus obtain the original unexpired term of the '199 patent to which he is entitled.

MPEP § 1402 also pointedly states that failure to make reference to or incorrectly making reference to prior copending applications are errors that may be corrected by reissuance under 35 U.S.C. § 251. The language of MPEP § 1402 is clear, unambiguous, and on point.

Case law, statutes, and legislative history of both 35 U.S.C. §§ 154 and 251 support and mandate the correction of an incorrect claim of priority through the use of a reissue application. Applicant respectfully submits that there is in fact no extension of the "original term of the patent"; rather, the Applicant is merely attempting to obtain the full original term of the patent he was entitled pursuant to 35 U.S.C. § 154. If the Decision Terminating Proceeding is allowed to stand, the Applicant will be left without recourse to

correct an error that left him with an all but worthless patent with a six (6) year term, an error that essentially destroys his statutory right to exclude others from making, using, and selling his claimed invention. Such a result is inequitable, contrary to both the letter and spirit of 35 U.S.C. §§ 154 and 251, and abhorrent to the U.S. patent system mandated by Art. I, Sec. 8, Cl. 8 of the U.S. Constitution.

The Examiner has rejected currently pending claims pursuant to 35 U.S.C. § 251. The Examiner maintains that the reissue filed by the Applicant is defective because the error that is relied upon to support the reissue application, is not an error upon which a reissue can be based. Succinctly stated, the Examiner's position is that an erroneous claim of priority can not be corrected by a reissue application. The Examiner's position is at odds with both the literal statutory language as well as the broad remedial purpose of the reissue statute as outlined in 35 U.S.C. § 251.

Contrary to the Examiner's assertion, the Applicant is not trying to extend the term of the original patent. The Applicant is merely attempting to correct an erroneous claim of priority and, consequently recapture the full and rightful original term of the issued patent. The Applicant's use of the reissue statute to correct such an error is appropriate and well within the scope of the statute.

The reissue statute's main purpose is to allow Applicant's to correct mistakes that unnecessarily limit the scope of patent protection to which they

are legally entitled. Unnecessary priority information that was not required for patentability was mistakenly included in U.S. Patent No. 5,861,199 (the '199 patent), as originally issued, without deceptive intent on the part of the Applicant. Pursuant to 35 U.S.C. § 251, such a mistake or error results in (1) an error which renders the patent wholly or partly inoperative, and (2) causes a severe, unjustifiable, and inequitable loss of patent protection - i.e. a substantially and unnecessarily shortened term. The '199 patent was issued with incorrect and unrequired continuing data (i.e. referencing back through a chain of references that includes 27 continuation-in-part applications) thereby shortening the original unexpired term of the original patent.

The Examiner argues that the Applicant cannot correct this error because correcting the error would extend the patent term. Such a line of reasoning is circular at best and turns the reissue statute on its head. Contrary to the Examiner's contention that the correction of the error in the '199 patent would "increase" the term of the '199 patent, the correction of the error in the '199 patent would merely reinstate the full unexpired original term to which the Applicant is entitled. Such an outcome is surely equitable and well within the goals and purposes of the broad and remedial reissue statute.

The Applicant's inadvertent and mistaken reference to earlier applications significantly and unnecessarily reduces the original unexpired patent term to which the Applicant is otherwise entitled. If the cross-reference section in the

'199 patent were properly corrected through this reissue application, the Applicant would be granted a patent of a scope that is guaranteed by 35 U.S.C. § 154 . The legislative history makes it clear that equity shall guide 35 U.S.C. § 251 actions. See e.g. *Sampson v. Commissioner of Patents*, 195 U.S.P.Q. 136, 136 (D.D.C. 1976). An easily correctable error is keeping the Applicant from fully enjoying a full original patent term to which he is entitled. Once again, to follow the logic of the Examiner's argument leads to an equitable catch-22 situation: an error unnecessarily limits the term of an issued patent, but the error cannot be corrected through reissuance because to do so would purportedly extend the patent term. Such a catch-22 situation cannot rule the day and is, moreover, at odds with the spirit and purpose behind the reissue statute as outlined in the *Brenner* and *Sampson* decisions.

The Examiner also maintains that MPEP § 1402 does not support the correction of an incorrect priority claim through reissuance. The Examiner states, without support, that MPEP § 1402 only refers to errors that do not change the patent term. Such conclusory and unsupported statements may not form the basis of a rejection.

MPEP § 1402 pointedly states that failure to make reference to or incorrectly making reference to prior copending applications are errors that may be corrected by reissuance under 35 U.S.C. § 251. The language of MPEP § 1402 is clear, unambiguous, and on point. The Examiner's impermissible attempt at limiting the language of MPEP § 1402, to apply only to errors of an



incorrect reference, application number, date, etc., is not supported by any authority and is, once again, completely at odds with the broad remedial purpose and clear and concise language of the reissue statute. The Examiner's attempt to place restrictions on § 1402 is contrary to the plain language of § 1402 as well as being contrary to 35 USC § 251.

Case law, statutes, and legislative history of both 35 U.S.C. §§ 154 and 251 support and mandate the correction of an incorrect claim of priority through the use of a reissue application. Applicant respectfully submits that there is in fact no extension of the "unexpired original term of the patent": rather, the Applicant is merely attempting to obtain the full unexpired original term of the patent to which he was entitled pursuant to 35 U.S.C. § 154. If the Examiner's line of reasoning were followed, the Applicant would be left without recourse to correct an error that fundamentally limits his statutory right to exclude others from making, using, and selling his claimed invention. Such a result is inequitable, contrary to both 35 U.S.C. §§ 154 and 251, and abhorrent to the U.S. patent system mandated by Art. I, Sec. 8, Cl. 8 of the U.S. Constitution.

The Examiner's objection to the grounds for reissuance should be reversed, the reissue application considered in its proper order, the claims examined in light of the correct priority date, and the patent reissued in an expedient manner.

## **XII. CONCLUSION**

The error relied upon by the Applicant is a proper basis for the reissue of an issued U.S. Patent, the Examiner's rejection should be overruled, and the case remanded to the Examiner with instructions to examine the claims in light of the correct priority date.

Respectfully submitted,



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